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Paper No. 7

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OFFICE OF PETITIONS

In re Application of :
Ramaprabhak H. Sathyaranayanan : DECISION GRANTING PETITION
Application No. 09/834,833 : UNDER 37 CFR 1.137(b)
Filed: April 13, 2001 :
Attorney Docket No. M-9213 US :
:

This is in response to the communication entitled "Petition to Confirm Good Standing of Patent Application," which is being treated as a under 37 CFR 1.183 to waive the rules such that the filing of the PCT application, which explicitly identified the subject US application, be the notification required by 35 U.S.C. § 122(b)(2)(B)(iii). Alternatively, the petition is being treated as a petition under 37 CFR 1.137(b) to revive the instant nonprovisional application for failure to notify the U.S. Patent and Trademark Office (USPTO) of the filing of an application in a foreign country or under a multinational treaty that requires publication of applications eighteen months after filing. See 37 CFR 1.137(f).

The petition under 37 CFR 1.183 is **DISMISSED**.

The petition 37 CFR 1.137(b) is **GRANTED**.

Petitioner states that the instant nonprovisional application is the subject of an application filed in an eighteen month publication country on April 11, 2002. However, the USPTO was unintentionally not notified of this filing within 45 days subsequent to the filing of the subject application in an eighteen month publication country.

BACKGROUND

The instant application was filed on April 13, 2001, which included a Request and Certification Under 35 U.S.C. § 122(b)(2)(B)(i) to not publish the application. The nonpublication request stated:

I hereby certify that the invention disclosed in the attached application **has not and will not be** the subject of an application filed in another country, or under a multilateral agreement, that requires publication at eighteen months after filing. I hereby request that the attached application not be published under 35 U.S.C. 122(b).

On April 11, 2002, applicant filed a counterpart international application relating to the subject matter of the above-identified application. Applicant, on April 12, 2002, filed a Request to Rescind Previous Nonpublication Request 35 U.S.C. 122(b)(2)B)(ii), but did not notify the U.S. Patent and Trademark Office (USPTO) that this application was being filed as a counterpart international application. Notification of the filing of the counterpart international application as required by 35 U.S.C. § 122(b)(2)(B)(iii) and 37 CFR 1.213(c) was provided at the time of filing of the instant petition.

As the notification to the USPTO of the foreign filing on April 11, 2002 of the counterpart international application did not occur within 45 days of such filing, this application is regarded as abandoned as of midnight on May 26, 2002.

STATUTE AND LEGISLATIVE HISTORY

35 U.S.C. (b)(2)(B) states, in pertinent part:

(i) If an applicant makes a request upon filing, certifying that the invention disclosed in the application has not and will not be the subject of an application filed in another country, or under a multilateral international agreement, that requires publication of applications 18 months after filing, the application shall not be published as provided in paragraph (1).

(ii) **An applicant may rescind a request made under clause (i) at any time.**

(iii) An applicant who has made a request under clause (i) but who subsequently files, in a foreign country or under a multilateral international agreement specified in clause (i), an application directed to the invention disclosed in the

application filed in the Patent and Trademark Office, shall notify the Director of such filing not later than 45 days after the date of the filing of such foreign or international application. **A failure of the applicant to provide such notice within the prescribed period shall result in the application being regarded as abandoned**, unless it is shown to the satisfaction of the Director that the delay in submitting the notice was unintentional.

(iv) If an applicant rescinds a request made under clause (i) **or** notifies the Director that an application was filed in a foreign country or under a multilateral international agreement specified in clause (i), the application shall be published in accordance with the provisions of paragraph (1) on or as soon as is practical after the date that is specified in clause (i).¹

The Congressional record explains that, if applicant has requested nonpublication because the application will not be filed "in a foreign country with a publication requirement, subparagraph (B)(iii) imposes a duty on the applicant to notify the Director of this fact. An unexcused failure to notify the Director will result in abandonment of the application." See 145 Cong. Rec. S14,718 (November 17, 1999).

PETITION UNDER 37 CFR 1.183

Applicant contends that notification of foreign filing was made in the above-identified application through the filing of a PCT application which was accompanied by a transmittal letter (Exhibit B) explicitly identifying the above-identified application and that the transmittal letter and PCT application were enclosed in the same envelope. Therefore, the USPTO, as the Receiving Office, was provided with notice by the transmittal letter and that such notice was provided on the same day as the filing of the PCT application because all papers were transmitted in the same envelope. Petitioner further contends that notification was made of the PCT filing in that the USPTO acted on this notification by granting a foreign filing license. Petitioner additionally contends that the USPTO recorded in its computer system that the PCT application was

¹ Emphasis added.

a child of the instant application, "again proving that the Commissioner had received 'actual notice' of the filing of the PCT application."

Petitioner requests that, "[t]o the extent the letter in Exhibit B does not identify any other rule of the USPTO, Applicant respectfully requests the Commissioner to retroactively waive such a rule (as of the date of filing of the letter)." However, should the Commissioner determine that the application has been abandoned for failure to satisfy the foreign filing notice requirement of 35 U.S.C. § 122(b)(2)(B)(iii), then petitioner requests that the application be revived pursuant to the provisions of 37 CFR 1.137(b)/(f).

Petitioner's argument that identification of the instant application in a transmittal letter for the filing of a PCT application in the USPTO as the Receiving Office was notification to the USPTO of a foreign filing is not persuasive. In this regard, 37 CFR 1.213(c) requires the applicant to provide notice, and 37 CFR 1.4(b) provides that each application must be complete in itself. An international application would not be placed into the file of an application that it relies upon for the benefit of an earlier filing date, and so applicant was required to file a separate paper pursuant to 37 CFR 1.4(b) in the above-identified application. Therefore, the mere filing of a PCT application is not the notification required by 35 U.S.C. § 122(b)(2)(B)(iii) and 37 CFR 1.213(c). Petitioner's attention is also directed to 37 CFR 1.4(c), which states:

Since different matters may be considered by different branches or sections of the United States Patent and Trademark Office, each distinct subject, inquiry or order must be contained in a separate paper to avoid confusion and delay in answering papers dealing with different subjects.

Pursuant to 37 CFR 1.4(c), the separate paper was required to address a distinct subject, so a notification of foreign filing was required to be on a separate paper from another matter (such as a new application), and so the mere filing of the international application, which references the application number and filing date of the subject application, in the United States Receiving Office would not have been notice of foreign filing.

Petitioner's inclusion of a transmittal letter identifying the instant application in filing a PCT application in the USPTO Receiving Office does not constitute the notice contemplated by 35 U.S.C. 122(b)(2)(B)(iii). Further, as the Office has no authority to waive the 45 day period set forth in 35 U.S.C.

122(b)(2)(B)(iii), the application must be regarded as abandoned. **These are statutory requirements and statutory requirement can not be waived under the provisions of 37 CFR 1.183.**

PETITION UNDER 37 CFR 1.137(f)

Turning now to the alternative petition, a petition to revive an application abandoned pursuant to 35 U.S.C. 122(b)(2)(B)(iii) for failure to notify the USPTO of a foreign filing must be accompanied by:

- (1) notification of such filing in a foreign country or under a multilateral international agreement;
- (2) the petition fee as set forth in 37 CFR 1.17(m); and
- (3) a statement that the entire delay in filing the required reply from the due date of the notification until the filing of a grantable petition was unintentional.

The instant petition has been found to be in compliance with 37 CFR 1.137(b). Accordingly, the failure to timely notify the USPTO of a foreign or international filing within 45 days after the date of filing of such foreign or international application as provided by 35 U.S.C. § 122(b)(2)(B)(iii) and 37 CFR 1.213(c) is accepted as having been unintentionally delayed.

As authorized, the \$1,300 fee required by statute for the petition under 37 CFR 1.137(b) will be charged to petitioner's Deposit Account No. 50-2263.

Any inquiries concerning this decision may be directed to the undersigned at (703)305-8680.

This application is being forwarded to Technology Center Art Unit 2172 to await a reply to the nonfinal Office action of June 6, 2003. Failure to timely reply will again result in the abandonment of the application.

Frances Hicks
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Office of Petitions
Office of the Deputy Commissioner
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